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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,803	12/02/2003	Thomas J. Maginot	22220-08626	4106
758	7590	07/15/2004	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,803	Applicant(s) MAGINOT, THOMAS J.	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/6/04 + 12/2/03</u> | 6) <input type="checkbox"/> Other: _____ |

Terminal Disclaimers

The transmittal referred to terminal disclaimers filed therewith. However, the Examiner could not locate them. For this reason, the Applicant is respectfully requested to provide replacement copies thereof in response to this Office action

Information Disclosure Statements

The Examiner considered the IDS's to the extent possible. However, certain non-patent literature documents could not be located in the file. The citations for the missing documents have been struck from the PTO-1449. Applicant is respectfully requested to provide replacement copies of these references in response to this Office action so that these references can be considered. Since the missing documents were apparently the fault of the USPTO, the normal fee requirement is hereby waived.

Specification

The disclosure is objected to because of the following informalities:

The continuing data has not been updated with the current status of each parent application. In addition, some of the patented applications have been marked as copending even though they are no longer pending.

Appropriate correction is required.

Claim Objections

Claim 5 is objected to because of the following informalities:

Regarding claim 5, on line 4, the term "position" is grammatically awkward in that it does not fit with the other verb tenses. For this reason, the Examiner suggests

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changing it to "positioning" in order to overcome this objection. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-6 of U.S. Patent No. 6,401,721.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader in scope as compared to the patented claims but are read on by the patented claims. For this reason, the present claims are considered to be clearly obvious in view thereof.

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No.

5,749,375. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader in scope as compared

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to the patented claims but are read on by the patented claims. For this reason, the present claims are considered to be clearly obvious in view thereof.

Claims 11, 12, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 12, and 15 of U.S. Patent No. 5,571,167. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader in scope as compared to the patented claims but are read on by the patented claims. For this reason, the present claims are considered to be clearly obvious in view thereof.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilk (US 5,287,861). Wilk anticipates the claim language where the instrument as claimed is the catheter of Wilk, the blood-conveying conduit as claimed is the stent of Wilk, and the anastomosis as claimed is formed in the coronary artery; see Figures 3A to 3D and 5A to 6C as well as columns 3 to 5.

With regard to claim 4, the heart wall is outside the artery or blood vessel.

With regard to claim 6, the visualization device is the CAT-scanner or MRI machine; see column 6, lines 2-10.

With regard to claim 8, the endoscope as claimed is the measuring rod, CAT-scanner, or MRI machine used to examine the interior of the body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (article entitled "Direct Reconstruction for Aortoiliac Occlusive Disease") in view of Ablaza (US 4,190,909). Brewster teaches side-to-end anastomosis of arteries with a blood-conveying conduit, but fails to teach doing so under substantially intact skin; see pages 674 to 676. However, Ablaza teaches that it was known to keep skin substantially intact because Ablaza keeps the skin substantially intact by using only an incision where the connection point is under completely intact skin. The terminology "substantially" of "substantially intact" is being treated as a broad term, which encompasses skin that has been cleanly incised with a scalpel, for example. Therefore, it is the Examiner's position that it would have been prima facie obvious to implant the Brewster graft under "substantially intact skin" so that bleeding and trauma to the skin could be reduced and so that a clean barely visible scar would result upon healing.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (US 5,287,861) in view of Loiterman (US 4,983,165). Wilk fails to disclose the use of a visualization device or endoscope with the catheter thereof. However, Loiterman teaches that it was known to the art at the time the invention was made to use visualization devices and endoscopes with catheters; see column 1, lines 13-21. Therefore, it is the Examiner's position that it would have been prima facie obvious to use a visualization device or endoscope with the Wilk method so that the progress of the operation could be more fully monitored making it safer.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster and Ablaza as applied to claims 1-5 and 7 above, and further in view of Loiterman (US 4,983,165). Brewster fails to teach the use of an endoscope as claimed. However, Loiterman teaches that it was known to the art at the time the invention was made to use endoscopes with catheters; see column 1, lines 13-21. Therefore, it is the Examiner's position that it would have been prima facie obvious to use an endoscope with the Brewster method so that the progress of the operation could be more fully monitored making it safer.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster and Ablaza as applied to claims 1-5 and 7 above, and further in view of Barone et al (US 5,360,443). Brewster teaches attaching a graft to the arteries with sutures, but not with a stent as claimed. However, Barone teaches that it was known to use a stent to mount the end of a bypass graft inside the blood vessel at the end of the graft; see Figures 1 to 4 and column 5, line 40 to column 6, line 54. Therefore, it is the

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Examiner's position that it would have been prima facie obvious to attach the graft of Brewster to the artery with a stent as taught by Barone for the same reasons that Barone uses the same and in order to have a smoother transition from the native vessel to the graft than that of a end-sutured end.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738